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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,594	09/30/1999	RONALD W. BASSETT	AT9-99-254	5602
35525	7590	03/24/2008	EXAMINER	
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			SALCE, JASON P	
			ART UNIT	PAPER NUMBER
			2623	
			NOTIFICATION DATE	DELIVERY MODE
			03/24/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

**Office Action Summary**

<b>Application No.</b> 09/409,594	<b>Applicant(s)</b> BASSETT ET AL.	
<b>Examiner</b> Jason P. Salce	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 20 December 2007.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-9, 11-30 and 32-44 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-9, 11-30 and 32-44 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All   b)  Some \*   c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_.

### DETAILED ACTION

In view of the Appeal Brief filed on 12/20/2007, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2623

In response to the arguments presented in the Appeal Brief filed 12/20/2007, Applicant states that claim 1 recites a two step process. The inconsistency of a three step process and two step process was stated by the examiner in regards to the 112 1<sup>st</sup> Paragraph made by the examiner in the previous Office Actions.

As stated by the examiner, claim 1 recites a three step process, where video/audio streams are received (**the first step**), a subset of video/audio streams are selected (**the second step**) and responsive to user input, selecting a plurality of video streams from the video stream subset for the event, and one or more audio streams from the audio stream subset for the event, wherein the selecting step omits ones of the video stream subset while retaining the selected plurality of video streams, and omits ones of the audio stream subset while retaining other ones of the audio stream subset (**the third step**).

As clearly taught by Applicant's specification on Pages 21-22 and Figure 8, a user selects programming to be retrieved from a distributed database at step 800 (**therefore causing a set of video streams to be received which has been identified by the examiner as the first step**). Applicant's specification further teaches at steps 806, 808, 814 and 816 of Figure 8 that a subset of the video/audio streams are selected and the selections are stored in a user profile (**therefore teaching selecting subsets of video/audio streams which has been identified by the examiner as the second step**). However, after this second step has been taught by the specification, the third step is simply the synchronization and display of the video/audio streams on Page 23 and steps 818 and 820 of the specification. No additional step is taught for further selecting video/audio streams from the selected subset.

Applicant states in the Appeal Brief on Page 15, 3<sup>rd</sup> Paragraph that this additional step is taught on Page 18, Lines 10-23, where the specification teaches that it is possible to make the overlays (**also stated at the bottom of Page 17 to be only video**

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**overlay streams**) selectable and as an example, selecting a player's "name overlay" might for example bring up an overlay with that player's biography.

The examiner disagrees that this passages teaches the third step for two reasons. The first reason results from the claims specifically teaching that one or more audio streams are additionally selected from the subset of selected audio streams, however this additional teaching on Page 18 only teaches a video overlay stream being additionally selected. The examiner notes that the passage on Page 18 fails to teach that one or more audio streams are further selected from the selected subset of audio streams (**only a single additional video overlay stream**). The second reason results from the claim reciting that responsive to user input, selecting a plurality of video streams for concurrent display. The examiner notes that Page 18 of Applicant's specification only teaches that a single additional video overlay stream is being selected from the subset of selected video overlay streams (**the football game video stream and the "name overlay" video stream, where the user selects the name overlay video stream and a single additional biography video overlay stream is displayed**).

Therefore, based on the teachings of Applicant's specification and the arguments presented in Applicant's Appeal Brief, claim 1 (**and all independent claims corresponds to claim 1**) fail to support the claim limitations based on the written description requirement of U.S.C. 112 1st Paragraph.

On Page 17 of the Appeal Brief, the Applicant has clarified the distinction between independent claim 1 (**and all corresponding claims**) and claim 14 (**and all corresponding claims**). Instead of receiving a set of audio/video streams, selecting a subset and then selecting another subset, Applicant had amended the claims to recite providing a set of video/audio streams (**which reads on the distributed database that stores programming at step 800 in Figure 8 of Applicant's specification**), receiving the video/audio streams from the set of video/audio streams (**receiving selected (set) of video/audio streams from the distributed database**) and then selecting a subset of video streams and one or more audio streams (**steps 802-816 of Figure 8**). The examiner agrees that the claim, in regards to the video/audio streams, reads on Figure 8 of Applicant's specification. Therefore, the rejection under U.S.C. 112 1st Paragraph has been rescinded.

Also in view of the arguments made in the Appeal Brief, the examiner further notes that a new grounds of rejection has been applied to the claims (see the rejection below).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9, 11-13, 22-30, 32-34 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In response to the arguments presented in the Appeal Brief filed 12/20/2007, Applicant states that claim 1 recites a two step process. The inconsistency of a three step process and two step process was stated by the examiner in regards to the 112 1<sup>st</sup> Paragraph made by the examiner in the previous Office Actions.

As stated by the examiner, claim 1 recites a three step process, where video/audio streams are received (**the first step**), a subset of video/audio streams are selected (**the second step**) and responsive to user input, selecting a plurality of video streams from the video stream subset for the event, and one or more audio streams from the audio stream subset for the event, wherein the selecting step omits ones of the video stream subset while retaining the selected plurality of video streams, and omits ones of the audio stream subset while retaining other ones of the audio stream subset (**the third step**).

As clearly taught by Applicant's specification on Pages 21-22 and Figure 8, a user selects programming to be retrieved from a distributed database at step 800 (**therefore causing a set of video streams to be received which has been identified by the examiner as the first step**). Applicant's specification further teaches at steps 806,808, 814 and 816 of Figure 8 that a subset of the video/audio streams are selected

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and the selections are stored in a user profile (**therefore teaching selecting subsets of video/audio streams which has been identified by the examiner as the second step**). However, after this second step has been taught by the specification, the third step is simply the synchronization and display of the video/audio streams on Page 23 and steps 818 and 820 of the specification. No additional step is taught for further selecting video/audio streams from the selected subset.

Applicant states in the Appeal Brief on Page 15, 3<sup>rd</sup> Paragraph that this additional step is taught on Page 18, Lines 10-23, where the specification teaches that it is possible to make the overlays (**also stated at the bottom of Page 17 to be only video overlay streams**) selectable and as an example, selecting a player's "name overlay" might for example bring up an overlay with that player's biography.

The examiner disagrees that this passages teaches the third step for two reasons. The first reason results from the claims specifically teaching that one or more audio streams are additionally selected from the subset of selected audio streams, however this additional teaching on Page 18 only teaches a video overlay stream being additionally selected. The examiner notes that the passage on Page 18 fails to teach that one or more audio streams are further selected from the selected subset of audio streams (**only a single additional video overlay stream**). The second reason results from the claim reciting that responsive to user input, selecting a plurality of video streams for concurrent display. The examiner notes that Page 18 of Applicant's specification only teaches that a single additional video overlay stream is being selected from the subset of selected video overlay streams (**the football game video stream**



and the "name overlay" video stream, where the user selects the name overlay video stream and a single additional biography video overlay stream is displayed).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9, 11-21, and 43-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 43-44 specify a computer program and the programming steps that define the computer program. The examiner notes that a computer program with no corresponding structure to execute the program has been deemed non-statutory subject matter (**see MPEG 2106**).

The examiner further notes that since method and system claims are both recited, a determination cannot be made whether the method claims correspond to the system or computer program product, therefore the method claims are also rejected as corresponding to the non-statutory computer program product claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11, 13-30, 32 and 34-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Freeman et al. (U.S. Patent No. 5,861,881).

Referring to claim 1, Freeman discloses a method in a data processing system for user controlled selection of multimedia data stream for an event (**see Figure 1 and Column 4, Lines 7-14 for providing a data processing system with user controlled selection for interacting with a program and Column 5, Lines 55-62 for providing user inputs to the system for personalized the programming received by the data processing system**).

Freeman also discloses receiving a set of video streams and a set of audio streams (**see Column 4, Lines 32 through Column 5, Line 5 for receiving a set of audio and video streams from various sources, therefore, audio and video streams received from sources 38 and 42 comprise a complete set**).

Freeman also discloses selecting a subset of the set of video streams and a subset of the set of audio streams (**see Column 5, Lines 38-45 for selecting a subset (a specific input source) in response to interactive commands**).

Freeman also discloses that responsive to user input to the data processing system (**see Column 5, Lines 55-56**), selecting a plurality of video streams from the video stream subset for the event (**see Column 5, Lines 56-62, Column 12, Lines 31-49 and Column 13, Lines 46-61 for selecting a plurality of video overlay streams (the video displayed on the screen and the pop-up overlays to be displayed while**

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***watching the television program, as defined by Applicant's specification on Page 18) from a subset***), and one or more audio streams from the audio stream subset for the event (see Column 5, Lines 56-62, Column 12, Lines 31-49 and Column 14, Lines 8-67 for selecting a plurality of audio streams from a subset), wherein the selecting step omits ones of the video stream subset while retaining the selected plurality of video streams (see again Column 5, Lines 56-62, Column 12, Lines 31-49 and Column 13, Lines 46-61 for selecting a plurality of video overlay streams from a subset, which therefore omits video streams that have not been selected), and omits one so the audio stream subset while retaining other ones of the audio stream subset (see Column 5, Lines 56-62, Column 12, Lines 31-49 and Column 14, Lines 8-67 for selecting a plurality of audio streams from a subset, which therefore omits audio streams that have not been selected).

Freeman also discloses presenting each of the retained plurality of video streams concurrently with one another (see Column 13, Lines 46-59 for displaying the video signal with video overlay streams (*note above for a video stream such as a football game and a video overlay streams such as a pop-up graphics window both comprising a selected (plurality of) video streams as described by Page 18 of Applicant's specification*)), and also concurrently with the retained other ones of the audio stream subset (see Column 14, Lines 10-16 and Lines 58-67 for providing audio streams concurrently with the selected video streams).

Referring to claim 2, Freeman discloses presenting the video stream on a display **(see Monitor 16 in Figure 1)**.

Freeman also discloses altering a location in the display in which the video stream is presented **(see Column 15, Lines 64-67 and Column 16, Lines 1-29)**.

Referring to claim 3, Freeman discloses selecting different selected ones of the set of video streams for presentation simultaneously with one another **(see Column 12, Lines 39-49 and Column 13, Lines 46-59 for selecting multiple/different selected ones of the set of video streams (video and graphics) for presentation)**.

Referring to claim 4, see the rejection of claim 3. The examiner also notes that Column 13, Line 62 through Column 14, Line 7 for changing the video streams presented on the display based on the user's answers to the multitude of questions.

Referring to claim 5, Freeman discloses selecting different selected ones of the set of audio streams for presentation **(see Column 14, Lines 10-16 and 58-67)**.

Referring to claim 6, see the rejection of claim 5. The examiner also notes Column 14, Lines 16-31 for outputting multiple audio streams based on the user's previous responses.

Referring to claim 7, Freeman discloses receiving a set of information streams including text (**see Column 19, Lines 20-24 and 30-32 for a specific example of displaying text to a user viewing and/or playing an interactive program**).

Freeman also discloses that responsive to the user input, selectively presenting selected ones of the sets of information streams on a display (**see Column 19, Lines 42-47 for accessing an interactive program and displaying additional web site text information according to the user's inputs**).

Referring to claim 8, Freeman discloses that the set of video streams and the set of audio streams include time stamps and synchronizing the selected ones of the video stream with the selected ones of the audio stream using the time stamps (**see Column 11, Line 19 through Column 12, Line 31**).

Referring to claim 9, Freeman discloses that the set of video streams and the set of audio streams include data packets located in the video and audio data streams periodically and synchronizing the selected ones of the video stream with the selected ones of the audio stream using the data packets (**see Column 11, Line 19 through Column 12, Line 31**).

Referring to claim 11, Freeman discloses a computer at Column 4, Lines 15-20 and element 6 in Figure 1.

Referring to claim 13, Freeman discloses a television at Column 7, Lines 38-43.

Referring to claim 14, Freeman discloses a method of tailoring a multimedia presentation of an event on a computerized multimedia system (**see Figure 1 and Column 4, Lines 7-14 and Column 5, Lines 55-62 for tailoring a multimedia presentation of an event based on user-specified inputs provided to a multimedia system**).

Freeman also discloses providing a set of video streams, a set of audio streams and a set of information streams for the event via a network coupled to the computerized multimedia system (**see Column 4, Line 58 through Column 5, Line 27 and Column 19, Lines 33-47 for video, audio and information streams being provided from different sources**).

Freeman also discloses receiving video, audio and information streams from the set of video, audio and information streams (**see again Column 4, Line 58 through Column 5, Line 27 and Column 19, Lines 33-47 for receiving the video, audio and information streams from the different sources**).

Freeman also discloses responsive to user input to the data processing system, selecting a plurality of the received video streams for the event, and also selecting one or more of the received audio streams for the event (**see Column 12, Lines 39-65, Column 13, Lines 46-58 and Column 16, Lines 39-55 for responsive to the user selecting a channel, being queried by a series of questions to determine a selection of further video overlay streams (graphics) and audio streams**).

Freeman also discloses responsive to user input, assigning each video stream of the selected plurality of video streams and the selected audio streams to respective portion of video and audio output devices (**see Column 15, Line 64 through Column 20 and Column 14, Lines 58-67 for outputting video overlay streams and audio streams in response to user input (*answers from the interrogatory questions*) on selected portions/positions of the video and audio output devices**).

Freeman also discloses presenting each video stream of the selected plurality of video streams concurrently with one another for the event (**see again Column 13, Lines 46-59 for displaying the video signal with video overlay streams (*note above for a video stream such as a football game and a video overlay streams such as a pop-up graphics window both comprising a selected (plurality of) video streams as described by Page 18 of Applicant's specification*)**), and also concurrently with the selected audio streams (**see Column 14, Lines 10-16 and Lines 58-67 for providing audio streams concurrently with the selected video streams and further note the specific example application at Column 19, Lines 20-32**).

Referring to claims 15-16, Freeman discloses that the steps of selecting the plurality of video streams and audio streams for presentation from the set of video and audio streams, respectively, for the event is performed in the computerized multimedia system (**see Figure 1 and Column 4, Line 8 through Column 5, Line 62 for the computerized multimedia system (interactive computer 6) performing the selection and presentation functions**).

Referring to claim 17, Freeman discloses that the set of video and audio streams are provided from a first source (**see element 38 in Figure 1 and Column 2, Lines 39-60**).

Referring to claim 18, Freeman discloses providing a second video stream from a second source (**see Column 2, Lines 39-60 and element 42 in Figure 1**).

Referring to claim 19, Freeman discloses providing a second audio stream from a second source (**see Column 2, Lines 39-46**).

Referring to claim 20, Freeman discloses that the set of video, audio and information streams are provided from at least two different sources (**see Column 2, Lines 47-60**).

Referring to claim 21, Freeman discloses that the set of video, audio and information streams are provided via a broadband network (**see Column 5, Lines 45-67 and Figure 5**).

Referring to claims 22-30, see the rejection of claims 1-9, respectively.

Referring to claim 32, see the rejection of claim 11.

Referring to claim 34, see the rejection of claim 13.



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Referring to claims 35-42, see the rejection of claims 14-21, respectively.

Referring to claims 43-44, see the rejection of claim 1 and 14, respectively.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. (U.S. Patent No. 5,861,881).

Referring to claim 12, Freeman discloses all of the limitations in claim 1, as well as the data processing system being a computer (**see the rejection of claim 11**), but fails to teach the use of a personal digital assistant.

The examiner takes Official Notice that personal digital assistants are well known to supplement computers for use in displaying multiple video, audio and text streams.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the computer, as taught by Freeman and Bobilin, using the personal digital assistant, for the purpose of providing the user with a compact device for receiving and viewing the different types of video, audio and data streams.

Referring to claim 33, see the rejection of claim 12.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2623

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March 16, 2008